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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,556	01/23/2002	Hiroyuki Terada	1614.1209	4977
21171	7590	09/20/2007	EXAMINER	
STAAS & HALSEY LLP			CHANDLER, SARA M	
SUITE 700			ART UNIT	
1201 NEW YORK AVENUE, N.W.			PAPER NUMBER	
WASHINGTON, DC 20005			3693	
			MAIL DATE	DELIVERY MODE
			09/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/052,556

Applicant(s)

TERADA, HIROYUKI

Examiner

Sara Chandler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's arguments and request for reconsideration of application 10/052,556 (01/23/02) filed on 07/13/07.

Claim Interpretation

1. In determining patentability of an invention over the prior art, all claim limitations have been considered and interpreted as broadly as their terms reasonably allow. See MPEP § 2111.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Pruter*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See MPEP § 2111.

2. All claim limitations have been considered. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art. See MPEP 2106 II C. The following language is interpreted as not further limiting the scope of the claimed invention. See MPEP 2106 II C.

Language in a method claim that states only the intended use or intended result (e.g., "for _____"), but the expression does not result in a manipulative difference in the steps of the claim. Language in a system claim that states only the intended use or intended result (e.g., "for _____"), but does not result in a

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structural difference between the claimed invention and the prior art. In other words, if the prior art structure is capable of performing the intended use, then it meets the claim.

Claim limitations that contain statement(s) such as "*if, may, might, can could*", as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.

Claim limitations that contain statement(s) such as "*wherein, whereby*", that fail to further define the steps or acts to be performed in method claims or the discrete physical structure required of system claims.

USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures or compositions of matter. See MPEP § 2106 II C.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

See MPEP § 2106 II C.

3. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct

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inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant's specification recites:

(c) sending fabrication order information to the fabrication factory and sending building materials order information including information of the fabrication factory that is a destination to ship building materials from a building materials manufacturer, based on the order received information. (Applicant's Specification, pg. 2)

Furthermore, Fig. 6 of Applicant's specification describes wherein the building materials order information is sent to the building materials manufacturer. (Applicant's Specification, Fig. 6, S604)

The claimed invention recites:

sending building materials order information, including information indicating which building materials are to be shipped to said construction company or to a builder, to said building materials manufacturer, based on said order received information. (Independent claims 1,4 and 5, Amendment filed 07/13/07)

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The specification and the claimed invention are shipping the building materials to different entities.

Claims 2,6 and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed invention recites:

wherein said order received information includes an image including a mark at a portion to be fabricated on a material, said mark indicating customized fabrication indication information. (Dependent claims 2,6 and 7, Amendment filed 07/13/07)

The claims are considered to incorporate new matter because they include subject matter that is not disclosed in Applicant's Specification or claims as originally filed.

Dependent claims are also rejected based on the same rationale as the claims from which they depend.

The following is a quotation of the second paragraph of 35 U.S.C. 112:.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re Claims 1,4 and 5: The claimed invention recites:

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coordinating between the fabrication factory and the building materials manufacturer by sending fabrication order information to said fabrication factory and sending building materials order information, including information indicating which building materials are to be shipped to said construction company or to a builder, to said building materials manufacturer, based on said order received information. (Independent claims 1,4 and 5, Amendment filed 07/13/07)

Claims 1,4 and 5 are indefinite because it is unclear how the fabrication factory and the building materials manufacturer are “coordinating” or actually working together. The “by” indicates that the language following it will describe the manner in which and/or steps required to achieve the coordination between the fabrication factory and the building materials manufacturer. The steps fail to describe how the coordination occurs however. For example, the fabricator and building materials manufacturer are both receiving orders but, how these orders are related is not clear.

Dependent claims are also rejected based on the same rationale as the claims from which they depend.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 3-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Reinsma, US Pub. No. 2002/0116239.

Re Claims 1,4 and 5: Reinsma discloses a method/apparatus comprising a computer/computer-readable recording medium for intermediating trading between a building materials manufacturer and a fabrication factory, said method/apparatus comprising a computer/computer-readable recording medium comprising the steps of: receiving order received information from a construction company (Reinsma, [0007] “a system is provided for selecting a set of items that meet a given criteria.” [0011]); and locating a fabrication factory satisfying requirements of said order received information from a storing part storing fabrication ability information of said fabrication factory (Reinsma, contractor= fabrication factory; Figs. 1,2,3,4, 4A, 6; [0071] “A contractor module 50 is employed to organize contractor schedules and to provide a list of available contractors and their installations costs for the items selected in the package.”[0075] “An alliance contractor database 78 may be accessed when determining an appropriate contractor and/or contractor schedule.” [0076][0078][0105] “the system may be used to permit manufacturers, builders, consumers, contractors, and suppliers to work together, which allows references to flow back and forth along the supply chain.....”); and coordinating between the fabrication factory and the building materials manufacturer by sending fabrication order information to said fabrication factory and sending building materials order information, including information indicating which building materials are to be shipped to said construction company or to a builder, to said building materials manufacturer, based on said order received information (Broadest reasonable interpretation: The step of coordinating between the fabrication factory and the building

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materials manufacturer has only two requirements to be satisfied: i.e., that the fabrication order is sent to the fabrication factory and that the building materials order is sent to the building materials manufacturer. This is accomplished by the prior art.

Reinsma, supplier= building materials manufacturer; Figs. 1,2,3,4,4A, 6; [0071] "An alliance supplier module 52 is employed to organize available suppliers and the cost of each product carried by the supplier." [0075][0076][0078][0105] "the system may be used to permit manufacturers, builders, consumers, contractors, and suppliers to work together, which allows references to flow back and forth along the supply chain.....").

Admission as Prior Art Also, applicant admits the prior art discloses:

coordinating between the fabrication factory and the building materials manufacturer by

(Broadest reasonable interpretation: The step of coordinating between the fabrication factory and the building materials manufacturer has only two requirements to be satisfied: i.e., that the fabrication order is sent to the fabrication factory and that the building materials order is sent to the building materials manufacturer. This is accomplished by the prior art)

sending fabrication order information to said fabrication factory,

Instead of having a factory the construction company may make an order of fabrication to a fabrication factory. (Applicant's Specification, Description of Related Art, pg. 2)

and sending building materials order information, including information indicating which building materials are to be shipped to said construction company or to a builder, to said building materials manufacturer, based on said order received information.

When the construction company receives the order made by the builder, the construction company determines building materials necessary for contents of an order received, and then makes an order of building materials that are determined, to a building materials wholesaler. When the building materials

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wholesaler receives the order of the building materials, the building materials wholesaler selects a building materials manufacturer for each building-material indicated in the order received. (Applicant's Specification, Description of Related Art, pg. 1)

Re Claim 3: Reinsma discloses the claimed invention supra and further discloses wherein said fabrication ability information includes open schedule information of said fabrication factory (Reinsma, [0071] "A contractor module 50 is employed to organize contractor schedules and to provide a list of available contractors and their installations costs for the items selected in the package." [0072][0096]).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reinsma, US Pub. No. 2002/0116239 in view of Thackston, US Pat. No. 6,295,513.

Re Claims 1, 4 and 5: Reinsma discloses a method/apparatus comprising a computer/computer-readable recording medium for intermediating trading between a building materials manufacturer and a fabrication factory, said method/apparatus comprising a computer/computer-readable recording medium comprising the steps of: receiving order received information from a construction company (Reinsma, [0007] "a system is provided for selecting a set of items that meet a given criteria." [0011]); and locating a fabrication factory satisfying requirements of said order received information from a storing part storing fabrication ability information of said fabrication factory (Reinsma, contractor= fabrication factory; Figs. 1,2,3,4, 4A, 6; [0071] "A contractor module 50 is employed to organize contractor schedules and to provide a list of available contractors and their installations costs for the items selected in the package." [0075] "An alliance contractor database 78 may be accessed when determining an appropriate contractor and/or contractor schedule." [0076][0078][0105] "the system may be used to permit manufacturers, builders, consumers, contractors, and suppliers to work together, which allows references to flow back and forth along the supply chain....."); and sending fabrication order information to said fabrication factory and sending building materials order information, including information indicating which building materials are to be shipped to said construction company or to a builder, to said building materials manufacturer, based on said order received information (Reinsma, supplier= building materials manufacturer; Figs. 1,2,3,4,4A, 6; [0071] "An alliance supplier module 52 is employed to organize available suppliers and the cost of each product carried by the

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supplier.” [0075][0076][0078][0105] “the system may be used to permit manufacturers, builders, consumers, contractors, and suppliers to work together, which allows references to flow back and forth along the supply chain.....”).

Admission as Prior Art Also, applicant admits the prior art discloses:

sending fabrication order information to said fabrication factory,

Instead of having a factory the construction company may make an order of fabrication to a fabrication factory. (Applicant's Specification, Description of Related Art, pg. 2)

and sending building materials order information, including information indicating which building materials are to be shipped to said construction company or to a builder, to said building materials manufacturer, based on said order received information.

When the construction company receives the order made by the builder, the construction company determines building materials necessary for contents of an order received, and then makes an order of building materials that are determined, to a building materials wholesaler. When the building materials wholesaler receives the order of the building materials, the building materials wholesaler selects a building materials manufacturer for each building-material indicated in the order received. (Applicant's Specification, Description of Related Art, pg. 1)

Reinsma fails to explicitly disclose coordinating between the fabrication factory and the building materials manufacturer.

Thackston discloses coordinating between the fabrication factory and the building materials manufacturer.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Reinsma by adopting the teachings of Thackston to provide coordinating between the fabrication factory and the building

materials manufacturer by sending fabrication order information to said fabrication factory and sending building materials order information, including information indicating which building materials are to be shipped to said construction company or to a builder, to said building materials manufacturer, based on said order received information.

As suggested by Thackston, one would have been motivated to diminish time consuming and costly business boundaries between parties.

Re Claim 3: Reinsma in view of Thackston discloses the claimed invention supra and Reinsma further discloses wherein said fabrication ability information includes open schedule information of said fabrication factory (Reinsma, [0071] "A contractor module 50 is employed to organize contractor schedules and to provide a list of available contractors and their installations costs for the items selected in the package." [0072][0096]).

Claims 2,6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reinsma as applied to claims 1,4 and 5 above, and further in view of Tan, US Pub. No. 2001/0018670.

Re Claims 2,6 and 7: Reinsma discloses the claimed invention supra and Reinsma further discloses wherein said order received information includes an image indicating fabrication indication information (Reinsma, [0076][0078]). Reinsma fails to explicitly disclose wherein said order received information includes an image including a mark at a portion to be fabricated on a material, said mark indicating customized fabrication indication information. Tan discloses wherein said order received information includes an image including a mark at a portion to be fabricated on a

material, said mark indicating customized fabrication indication information (Tan, abstract, [0003] [0005] [0006] [0012] Claims 1,8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Reinsma by adopting the teachings of Tan to provide wherein said order received information includes an image including a mark at a portion to be fabricated on a material, said mark indicating customized fabrication indication information. As suggested by Tan one would have been motivated to avoid delivering products for a construction project that are not suitable in order to avoid undue delay and/or expense.

Claims 2,6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reinsma and Thackston as applied to claims 1,4 and 5 above, and further in view of Tan, US Pub. No. 2001/0018670.

Re Claims 2,6 and 7: Reinsma in view of Thackston discloses the claimed invention supra and Reinsma further discloses wherein said order received information includes an image indicating fabrication indication information (Reinsma, [0076][0078]). Reinsma fails to explicitly disclose wherein said order received information includes an image including a mark at a portion to be fabricated on a material, said mark indicating customized fabrication indication information. Tan discloses wherein said order received information includes an image including a mark at a portion to be fabricated on a material, said mark indicating customized fabrication indication information (Tan, abstract, [0003] [0005] [0006] [0012] Claims 1,8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Reinsma and Thackston by adopting the teachings of Tan to provide wherein said order

received information includes an image including a mark at a portion to be fabricated on a material, said mark indicating customized fabrication indication information. As suggested by Tan one would have been motivated to avoid delivering products for a construction project that are not suitable in order to avoid undue delay and/or expense.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Applicant's specification implies that the "novelty" applicant relies upon is that the building materials manufacturer is aware of who the fabricator will be. Furthermore, that the building materials manufacturer ships the building material directly to the fabricator.

Applicant's specification suggests these features address the following problem:

However, in this case, it is difficult for the fabrication factory to deliver manufactured building materials on time ordered by the construction company because of the various order contents and a different order amount every time. (Applicants Specification, pg. 2).

As discussed supra, the claimed invention fails to do this.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Reinsma describes the benefits associated with allowing the various entities (e.g., suppliers, manufacturers, contractors, distributors etc.), involved in the construction of a structure to send and receive information, and coordinate. It is noted that the building materials manufacturer is a supplier because they are supplying the building materials; and the fabricator is a contractor because they contracting to perform the fabrication. Reinsma suggests that this exchange between the entities can lead to an optimized process wherein the criteria and requirements necessary to construct a structure is determined and the lowest cost can be obtained. (Reinsma, abstract, [0004] [0075] [0076]). See also citations supra. Thackston expands upon the teachings of Reinsma by describing a collaborative environment wherein information regarding qualified and capable fabricators is made available. Various entities (e.g., engineers, designers, contractors, manufacturers etc.) involved in the construction process may interact with (i.e., negotiate with, search a list of, coordinate with etc) with the fabricators. Thackston suggests that in a decentralized economy, the search for fabricators may involve a time consuming search and it may be hard to find the best fabricators leading to increased costs and decreased performance (Thackston, col. 2, line 60+ - col. 3, line 21). See also citations supra.

All citations supra are considered to be relevant to the claimed invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

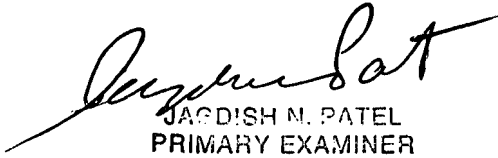
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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SMC


JAGDISH M. PATEL
PRIMARY EXAMINER